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No. 00-689

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NONPAREIL MUSIC, INC., WARNER CHAPPELL MUSIC LIMITED, WARNER TAMERLANE PUBLISHING CORP., WB MUSIC CORP., and SONY MUSIC ENTERTAINMENT, INC.,

Petitioners,

v.

THREE BOYS MUSIC CORPORATION,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

REPLY BRIEF

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Respondent's Brief in Opposition ("Resp. Brief") avoids the key issue presented to this Court: the Constitutional implications of the Ninth Circuit's opinion in chilling speech by upsetting the balance between copyright protected expression and First Amendment freeoms.

ARGUMENT

1. The Ninth Circuit Established a New Access Standard and Abrogated the Courts' Crucial Gate-keeping Function in Copyright Cases.

Contrary to Respondent's argument, the Ninth Circuit clearly did adopt and follow *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946) ("Arnstein"), and did set a new and improper standard for access, thereby abrogating the courts' necessary and traditional gate-keeping role in area of free speech. The standard imposed by the Ninth Circuit is the outdated, discredited *Arnstein* standard of virtually complete deference to juries — a standard rejected in other Circuits and contrary to this Court's opinions in both the summary judgment and free speech areas. That much is clear from the portion of *Arnstein* the Ninth Circuit quoted specifically on the issue of access:

> [I]n *Arnstein v. Porter*: "The judge characterized plaintiff's story as 'fantastic'; and in the light of the references in his opinion to defendant's deposition, the judge obviously accepted the defendant's denial of access and copying. . . . [Y]et plaintiff's credibility, even as to those improbabilities, should be left to the jury."

212 F.3d at 484, quoting *Arnstein*, 154 F.2d at 469. The Ninth Circuit standard relegates the courts to the role of complete "judicial deference" (212 F.3d at 482). It permits a jury to find access (and requires courts to sustain that finding) despite a plaintiff's "fantastic" or "improbable" theory

(as was Mr. Arnstein's theory that Cole Porter's "stooges" had broken into his house to steal his songs), relying only on so-called credibility determinations.[1]

Arnstein is predicated on the "slightest doubt" standard:

> The principal question on this appeal is whether the lower court, under Rule 56, properly deprived plaintiff of a trial of his copyright infringement action. The answer depends on whether "there is the slightest doubt as to the facts." 154 F.2d at 468 (citations omitted)

Although the Ninth Circuit did not use the words "slightest doubt," its explicit reliance on the facts and law of what it denominated the "seminal case" — *Arnstein* — re-adopts into the copyright law the discredited "slightest doubt" standard, just as surely as if those words had been used. (And, no doubt, future plaintiffs and courts, if permitted to rely on the Ninth Circuit opinion, will use those very words in describing the standard adopted below.)[2]

Significantly, in cases like these, this Court has recognized that the law is not developed by reference to generalized and vague bright lines, such as the "bare possibility" of access compared to the "reasonable opportunity" of access (to which, to be sure, the Ninth Circuit

1. It is now clear, contrary to *Arnstein*, that the denial of copying does not raise a credibility issue. *See* Brief of Amicus Curiae Recording Industry Association of America, Inc. ("RIAA Amicus Brief"), at 9 n.15; *Grubb v. KMS Patriots, L.P.*, 88 F.3d 1, 4 (1st Cir. 1996). *See also Bose Corp v. Consumers Union of U.S., Inc.*, 466 U.S. 485 (1984).

2. The Ninth Circuit expressly approved proof of infringement that it termed "highly circumstantial." The only previous copyright case to use the term "highly circumstantial" dismissed the claim of infringement precisely because the plaintiff's evidence was "highly circumstantial." *Morse v. Fields*, 127 F. Supp. 63, 69 (S.D.N.Y. 1954).

paid brief lip service); rather, the applicable standards emerge from decisions, such as *Arnstein* and the Ninth Circuit's opinion, and specifically from the facts that are deemed sufficient to satisfy those policy standards. As this Court stated in the First Amendment context of a trade disparagement case:

> [T]he content of the rule [requiring actual malice] is not revealed simply by its literal text, but rather is given meaning through the evolutionary process of common-law adjudication; though the source of the rule is found in the Constitution, it is nevertheless largely a judge-made rule of law.
>
> . . . .
>
> Providing triers of fact with a general description of the type of communication whose content is unworthy of protection has not, in and of itself, served sufficiently to narrow the category, nor served to eliminate the danger that decisions by triers of fact may inhibit the expression of protected ideas.

Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485, 502, 505 (1984).[3] *See also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 596 (1994) (Kennedy, J., concurring) (fair use standard); *Hurley v. Irish-American Gay, Lesbian, and Bisexual Group*, 515 U.S. 557, 567 (1995) ("[T]he reaches of the First Amendment are ultimately defined by the facts it is held to embrace. . . .").

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3. Put another way, cases "provide benchmarks against which future courts can compare and contrast new fact patterns." *See* E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review in Copyright Cases," 107 Yale L.J. 2431, 2432 (1998). These decisions also provide guidelines for future creators and publishers. *Id.* at 2440.

The Court in *Bose* held that precisely because of the First Amendment implications, it is necessary that the courts preserve and implement their gate-keeping function by applying the rule of independent appellate review to the question of actual malice. 466 U.S. at 514. *See also id.* at 505 (special responsibility on judges whenever it is claimed that a particular communication is unprotected by the First Amendment). Here, although such a rule of review would be salutary,[4] it is not necessary to reach that issue to provide the necessary clarification of the court's function in balancing copyright and First Amendment doctrines.[5] What the Ninth Circuit has done is to erode, if not completely obliterate, the traditional gate-keeping function mandated in First Amendment cases by requiring acceptance of "fantastic" and "improbable" access theories. Respondent does not cite a single case, and there is none, that has held the type of alleged access here to be sufficient. *See, e.g., Jason v. Fonda*, 526 F. Supp. 774, 776-77 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982) (no access where sale of 200-700 copies in area where defendant was located); *Takeall v. Pepsico, Inc.*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, No. 93-1237, 14 F.3d 596, 1993 WL 509876 (4th Cir. Dec. 8, 1993), *cert. denied*, 512 U.S. 1236 (1994) (plaintiff's appearance on 26 radio stations over 14 years, including performances on two New York City area stations while defendants lived there, was insufficient);[6] *Benson v. Coca-Cola Co.*, 795 F.2d 973, 975 (11th Cir. 1986) (no access where plaintiff had no evidence that defendant songwriters visited any place where

4. *See generally id.*

5. *See Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 54 n.3 (1986) (holding that the Court need not reach the issue of whether "appellate courts have a duty to review de novo all mixed findings of law and fact relevant to the application of First Amendment principles").

6. The district court opinion relied on the record and noted that there were numerous performances since 1964. The unpublished Fourth Circuit opinion described the record in greater detail, noting the plaintiff's performances on 26 radio stations in 14 years.

plaintiff's song was performed during the relevant time period); *McRae v. Smith*, 968 F. Supp. 559, 563 (D. Colo. 1997) (same). *Intersong-USA v. CBS, Inc.*, 757 F. Supp. 274, 281-82 (S.D.N.Y. 1991) (radio broadcasts of plaintiff's song in New York, where on one radio station it was one of ten most-played songs, and in Miami, even while the composers of the allegedly infringing song were in those cities, was insufficient); *Novak v. National Broadcasting Co.*, 752 F. Supp. 164, 170 (S.D.N.Y. 1990) (broadcast of plaintiff's skits several times on national television show held insufficient); *Jewel Music Publishing Co. v. Leo Feist, Inc.*, 62 F. Supp. 596, 598 (S.D.N.Y. 1945) (distribution of nearly 10,000 copies of sheet music and nationwide broadcasts on CBS and NBC "on a number of occasions" was insufficient).[7]

7. Although the Ninth Circuit recognized the rule that access is proven inferentially by a direct submission or wide dissemination, the "evidence" relied upon was of neither type. Plaintiff never claimed a direct submission. The only "evidence" of "wide dissemination" of the Isley song in Connecticut, where the teen-aged writers Bolton and Goldmark lived, was the testimony of one Philadelphia disc jockey who played it five or six times on his Philadelphia show which he "imagined" (without any support) was also broadcast in Connecticut. Instead, the sum total of such evidence was such *non-sequiturs* as: Bolton's brother had a record collection; Bolton had from time to time "covered" other African-American singers (always with consent and license); reference by Bolton to another (very popular) song by another well-known writer; an off-hand introductory remark (at a benefit), where the plaintiff's witnesses themselves changed their story; broadcast of the Isley song on one other television show and three radio stations outside of Connecticut; and a near appearance on one record chart for *one week*, which was consistent only with such extremely limited broadcast. Respondent's Brief (albeit inadvertently) reflects the lack of access evidence by using the same sleight of hand used at the trial — emphasizing that the Isleys were a "hot group" (Resp. Brief at 10), and that "the Isley Brothers . . . *works* are likely to be sought out by a substantial number of fans. . . ." (*Id.* n.7) (emphasis added).

(Cont'd)

By holding access sufficient, the Ninth Circuit has, indeed, changed the standard "through the evolutionary process of common-law adjudication."[8] By tying its decision to *Arnstein*, the Ninth Circuit has insured that this sea change will be echoed in future decisions.

This Court has recognized that any impingement on First Amendment speech must be monitored carefully by the courts:

> [T]he constitutional values protected by the rule make it imperative that judges — and in some cases judges of this Court — make sure that it is correctly applied.

Bose, 466 U.S. at 502. *See also Jenkins v. Georgia*, 418 U.S. 153, 159-161 (1974) (film could not as a matter of constitutional law be found obscene, despite finding of properly instructed jury).

In the area of copyright, this judicial gate-keeping must insure that the restriction on speech imposed by the copyright law is balanced by the requirement that a plaintiff prove copying, not just similarity. Generally, such proof is attempted, as was attempted here, through access and substantial similarity. Significant lowering of those standards upsets the balance between copyright law and First

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(Cont'd)
However, the only issue, of course, was access to this specific, single song for which there was no evidence of record sales and precious little evidence of air play.

8. Ironically, in doing so, the Ninth Circuit itself illustrated that on issues such as access the standards are set by the ***facts*** of cases. Thus, the Court at 212 F.3d at 483 reviewed and relied on the facts supporting access in *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983). The Court, however, does not explain that comparison with *Harrisongs* (where plaintiff's popular song was a number one hit in the U.S. and a hit in England) starkly illustrates the ***lack*** of such evidence here.

Amendment protections. Any such imbalance necessarily must result in the chilling of speech. *See Volokh & McDonnell* at 2437. That is particularly true for the copyright law, which imposes strict liability for subconscious copying, provides for huge damage awards against creators,[9] and where proof of copying can be established indirectly and by inference.

2. The Ninth Circuit Also Implemented And Imposed A New Standard For Protectibility Inconsistent With This Court's Ruling in Feist.

In *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340, 349, 359 (1991), this Court approved "thin" or "limited" copyright protection for compilations and arrangements. This is not such a case because it is not (as Respondent posits) the typical case that "consist[s] of selections and arrangements of unprotectible words or notes." (Resp. Brief at 12.) Rather, it was undisputed here only that the "combination" was of unprotectible ideas and musical devices (*see* Petition at 11 n.6). There was no claim that the "arrangement" was similar. No previous case ever had held the use of such disparate, literary devices — whether in music or other expression — to be copyright protectible.[10] The Ninth Circuit opinion not only distorts *Feist*, but once again upsets the First Amendment balance mandated by this Court:

> We note that Federal District Courts have rejected First Amendment challenges to the federal copyright law on the ground that "no restraint (has been) placed on the use of an idea or concept."

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9. Although Respondent's Brief notes that the largest award below was against Petitioner Sony Music Entertainment Inc., creators frequently may be asked to satisfy those awards. *See* RIAA Amicus Brief at 2 n.4.

10. Also contrary to Respondent's position, the issue of substantial similarity of expression is a mixed question of law and fact. *See* Discussion, RIAA Amicus Brief at 15-17.

Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 577 n.13 (1977). Contrary to Respondent's position (Resp. Brief at 12), ideas simply are not protected, even if used in combination.[11] This is crucial because "[t]he First Amendment protections [are] already embodied in the Copyright Act's distinction between copyrightable expression and uncopyrightable facts and ideas, ..." *Harper & Row v. Nation Enterprises*, 471 U.S. 539, 560 (1985); *see also New York Times Co. v. U.S.*, 403 U.S. 713, 726 (1971) (Brennan, J, concurring) (Copyright laws do not restrict free speech because copyright protects only expression, not ideas.) *See generally* M.B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?* 17 UCLA L. Rev. 1180 (1970). In permitting protection for "ideas," the Ninth Circuit's opinion conflicts both with *Feist* and other First Amendment/copyright decisions of this Court.

3. The Inverse Ratio Rule Presents An Issue Of Significant Importance And Was Determinative In This Case.

Contrary to Respondent's position, the Inverse Ratio Rule was of key importance to the Ninth Circuit's decision. The very first sentence of its discussion of substantial similarity invoked the Rule. 212 F.3d at 485. The Ninth Circuit's improvident and unreasoned application of the Rule as a "one way street" has never before been decided. The Rule itself is controversial (*see* Petition at 12 n.7) and has not been examined by this Court. Since (as Respondent acknowledges) copying is proven by access and substantial similarity, the relation between the two and the quantum of proof necessary for each, are implicated in a wide variety of copyright cases. *See* II P. Goldsten, Copyright § 7.2.1 at 7:7 (2nd ed. 2000) (referring to "reciprocal relationship between

11. Although this is an issue that is important to all copyright media, it is particularly important in the creation of music because "most popular music is simple by nature." (Resp. Brief at 13 n.10.)

proof of access and similarity . . ."); *see generally* 4 M. & D. Nimmer *On Copyright* § 13.01[B] at 13-11 to 13-13 (2000) (copying ordinarily established indirectly by proof of access and substantial similarity).

The Ninth Circuit reiterated that the evidence of access was "weak." 212 F.3d at 484 ("Despite the weakness of the Isley Brothers' theory of reasonable access . . ."); at 486 ("Although this may be a weak case of access . . ."); and *id.* ("In this case, there was a weak showing of access"). Given that fact, its refusal to apply the Inverse Ratio Rule evenly and reciprocally clearly was outcome-determinative; otherwise there would not have been any reason to discuss the Rule. What the Ninth Circuit did, in this issue of first impression but of broad importance, was to permit greater evidence of substantial similarity to replace at least some otherwise necessary evidence of access (thereby giving added weight to the copyright side of the free speech balance), but not to permit reciprocal application, i.e., to require greater similarity where evidence of access was "weak." *See* Discussion, RIAA Amicus Brief at 18-19. The Ninth Circuit's opinion skews the balance by prohibiting speech (as copyright protected) while limiting First Amendment protections. Contrary to Respondent's position (Resp. Brief at 15) Petitioners do not seek a new standard. By use of the Inverse Ratio Rule in the first place, courts already have imposed a sliding scale standard. Petitioners only asked that the standard be applied equally and reciprocally, as the First Amendment requires.

CONCLUSION

Respondent ignores that the issues presented involve serious First Amendment implications and the gatekeeping function of the courts required to balance those concerns with copyright protection. The Ninth Circuit's return to a rule of complete "judicial deference" splits that Court from other Circuits and is contrary to the decisions of this Court. For all of the reasons presented in the Petition and here, Petitioners respectfully submit that the Petition should be granted.

Respectfully submitted,

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